



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/027,010

12/21/2001

Gregory L. Renda

1270

2780

30748

7590

10/21/2005

INNOVATION PARTNERS
540 UNIVERSITY DRIVE
SUITE 300
PALO ALTO, CA 94301

EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,010

Applicant(s)

RENDA ET AL.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-22 and new claims 23-26 are pending.

Response to Arguments

2. Applicant's arguments filed 8/17/05 have been fully considered but they are not persuasive to overcome the prior art.

1. Double Patenting:

A. Applicant argues the present application recites "responsive to the at least one indication retrieved ... the source identifier received with the communication" means "the type of source identifier with which a communication is forwarded responsive to an indication having a first and second state".

Examiner points out the type of source identifier is not in claim language.

B. Applicant argues the ('011) recites "selectively granting access a network a communication received from a device having identifier received, responsive to the at least one set of at least one set of privileges received" which not described in current application.

Examiner points out "selectively granting access a network a communication received from a device having identifier received" in ('011) is equivalent to "having one selected from a first state and second state;" in current application; and "responsive to the at least one set of at least one set of privileges received" is equivalent to "responsive to the at least one indication retrieved having the first state".

Thus, the Double Patenting is sustained.

2. The 112 Rejection:

As per claims 1-22 are not being enabled, Applicant argues "the frame was received indicate that operation in real IP mode is possible".

Examiner points out the limitations was not in claim language.

3. The 102 Rejection:

a. As per claims 1,8,15,22, Applicant argues "a communication with one source identifier if the indication has a first state or (*emphazise added*) a different identifier if the indication has a second state" and the use of the term "and" in the claim language should not be meant to imply both source identifiers must be supplied.

Examiner points out the limitations "OR" was not recites in claim language. The limitation "AND" was used in claim language.

b. Applicant argues the XID teach or suggest the communication to be forwarded with an alternate identifier if the indication is in a second state.

Examiner points out the prior art taught "the routine continues by sending the information to a log and collects the router MAC ID and TCP/IP addresses [Keeler, col 6 lines 32-38].

Thus, the rejection sustained.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), *In re Van Ornum* 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 2142

1 982)', In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)', and, In re Thorington 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8, 15 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 23 and 34 of copending Application No. 10/027,011. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims at present application includes limitation of claims in ('011) such as method of forwarding a communication (selectively providing access to a network) comprising: receiving communication having source identifier (device identifier); retrieving at least one of said indication (providing a request for a set of at least one privileges, and receiving the request for the set of privileges; responsive to the at least one indication retrieved... ..the source identifier received with the communication (responsive to the device identifierthe set of privileges requested).

The only difference between claim 1 of present application and the claim 1 of ('011) is the present application claims first state and second state, wherein claim in the co-pending application discloses a set of privileges, by eliminating the additional function of the method step, or means for system and/or apparatus claim.

However, claims at present application for claiming more than one state such as first and second, is obvious and providing similar function as to the sets of privileges.

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to disclose the variation of the state for the outcome of the same result without having effect on its function.

Similarly, claims 8,15 and 22 of present application and the claims 12, 23, and 34 of co-pending applications are different in the similar way as in for claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for network access points, privileges of a class, does not reasonably provide enablement for a first state and a second state. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The feature as claimed "receiving for each of a plurality of users an indication having one selected from a first state and a second state" does not enable any skilled person in the art to refer to access points or privileges of class as in specification.

Claims 1,8,15,22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was unclear the users received both first and second state or either one.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by

Keeler, Jr. et al., US 6,502, 130.

5. Regarding to claimed invention of claims 1,8,15 and 22, as best understood, a method and an apparatus of forwarding communication comprising: receiving for each of users a identification, Keeler Jr. et al teaches a system and method which collects dynamic connectivity data from an area network interconnecting multiple computing devices; receiving the communication having a source identifier, The connectivity data identifying the address equipment connected to the network is combined with static network information such as the user's identity stored in the system data bases to re/ate the connectivity data to the respective users and their respective privileges", as disclosed in Abstract.

A method further comprising retrieving at least one indications; an responsive to the at least one indication retrieved having the first state, forwarding the communication

Art Unit: 2142

with the source identifier; and responsive to the indication retrieved having the second state, forwarding the communication with an alternate source identifier, Keeler Jr. et al teaches segment 12 connected to a controller 24, a communications over the SNA network 25 utilize the SNA protocol, and the identity of any workstation having privileges to communicate over the SNA network 25 stored as an SNA XID which provides alternative identity of the workstations, see col. 2, lines 40-52.

6. Regarding to claims 2-4, 6-7; 10-13; 17-19 and 21 Keeler Jr. et al teaches physical or MAC address for the authorized workstations which is used in the SNA network 25, and MAC address is used on the network segment 12 by controller 24, see col. 2, lines 48-52.

7. Regarding claimed communication comprising a packet as in claim 5, Keeler jr. discloses the router, as is known in standard network architecture, provides bridge from the first segment to the second segment for transferring data between segments, see col. 2, lines 34-40.

8. Regarding claims 8 and 9, claims recites similar features in system form as in method claim 1, and additionally recites the an access point manager and network address translation manager, Keeler Jr. et al teaches network manager 27 which keeps router list containing the community name for the router, as well as MAC address which is used in collection process for obtaining connectivity data from each router, see col. 2,

Art Unit: 2142

lines 53-59.

9. Regarding claimed communication comprising an identifier of a device forwarding the communication, Keeler Jr. teaches the router address, name and type is identified, see col. 5 line 63-col 6 line 5.

10. Claims 23,24,25,26 contain the similar limitations set forth in claims 1,8,15 and 22. Therefore claims 23-26 are rejected for the same rationale set forth in claims 1,8,15 and 22.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner
Art Unit 2142

